

Docket No. F-7051

Ser. No. 09/935,222

REMARKS

Claims 1-4 and 13-16 remain pending in this application. Claims 1-4 and 13-16 are rejected. Claims 5-12 and 17-24 are previously cancelled herein. Claim 1 is amended herein to clarify the invention.

CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-4 are now rejected under 35 U.S.C. §103(a) as obvious over the Mozer, Bain, von Bauer, and Scott references. The applicant herein respectfully traverses this rejection. For a rejection under 35 U.S.C. §103(a) to be sustained, the differences between the features of the combined references and the present invention must be obvious to one skilled in the art.

In the response and amendment filed October 11, 2005, it was argued that the prior art failed to disclose the call button or message button being conductive to discharge the static electricity. The Examiner presently cites the Bain reference for teaching a message input button. However, it is respectfully submitted that the rejection on the Office Action does not properly set forth a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings.

~~Docket No. F-7051~~~~Ser. No. 09/935,222~~

Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP §706.02(j) "Contents of a 35 U.S.C. §103 Rejection".

The rejection set forth does not address what teaching renders obvious making either the call button or the message the button conductive to effect static discharge. After stating that Bain discloses a message button, and that Bauer discloses an image pickup means, the Examiner specifically states:

... Mozer in view of Bain and in view of von Bauer as applied above *does not specifically disclose the outdoor unit having fingerprint input means for inputting fingerprint information of the visitor, unlock control means for unlocking the lock means if the fingerprint information input through the fingerprint input means agrees with registered fingerprint information, and at least one of the call button and the message input button being made of conductive material and grounded to effect static discharge in conjunction with finger depression to form an integrated static discharge and input button device.*

(Emphasis Added) Office Action, mailed January 26, 2006, pages 5-6. Hence, it is admitted there is no teaching to provide a conductive call or message button for grounding. The Examiner goes on to cite the Scott reference for teaching a biometric input used in conjunction with an unlocking apparatus stating:

~~Docket No. F-7051~~

~~Ser. No. 09/935,222~~

In an analogous art, Scott discloses the feature of the outdoor unit (Access Control Unit, Fig. 1, 100) having biometric information input means (finger print scanner, Fig. 1, 108)-for inputting biometric information on the visitor (Scott, Col. 3, lines 32 - 62) and the ACU (Access Control Unit) further having unlock control means for unlocking the lock means if the biometric information input through the biometric information input means agrees with registered biometric information (granting access to the individual after biometric analysis, Scott, Col. 1, lines 9 - 45) ...

With regard to the conductive message or call button, in view of the complete dearth of relevant disclosure in the applied references, the Office Action offers the following conclusory statement:

... it would have been obvious to one of ordinary skill in the art at the time the invention was made to use conductive material and have a connection connected to ground in order to get rid off static discharge when a user touches the outdoor unit so that it does not shock the circuitry within the outdoor unit as a preventive measure.

This rejection fails to state a *prima facie* case of obviousness because it does not identify where there is a suggestion made in the art to (1) remove static, (2) use a ground connection on the apparatus to remove the static, (3) incorporate the ground connection into a button, and/or (4) use a call button as the conductive button.

In contrast to the above assemblage of references, the invention of claim 1 specifically requires:

the call button being made of conductive material and grounded to effect static discharge in conjunction with finger depression to form an integrated static discharge and input button device.

Docket No. F-7051

Ser. No. 09/935,222

The feature of a call button, responsive to finger pressure, that is made of conductive material and grounded to effect static discharge in conjunction with finger depression to form an integrated static discharge and input button device provides for functions not suggested nor disclosed in the applied references.

Static discharge is required before operating the fingerprint inputting means since excessive static charge can damage the input means. One may therefore decide to advise users to discharge static. However, merely advising one to discharge to ground may not make the visitors recognize a grounded part and conduct static discharge. In this case, if the visitors touch the fingerprint inputting means, static discharge is conducted to destroy the fingerprint inputting means.

In a possible scenario, it might be the case that the visitors tend to be interested in the fingerprint inputting means and to touch the fingerprint inputting means thoughtlessly when waiting for an answer from a resident. Therefore, there is a risk that damage to the fingerprint inputting means may occur.

In recognition of this problem, the inventor has gone further than merely warning about static discharge, and has also gone beyond merely providing a part of the outdoor unit that is made of conductive material grounded to effect static discharge. Instead, the present inventor has taken a step nowhere suggested in the applied references of providing a call button responsive to finger pressure by the visitors that is made of conductive material and grounded to effect static discharge

Docket No. F-7051

Ser. No. 09/935,222

in conjunction with finger depression to form an integrated static discharge and input button device. Therefore, the visitors can conduct static discharge unconsciously when the visitors operate the call button. As a result, even if the visitors touch the fingerprint inputting means thoughtlessly when waiting for an answer from a resident, damage to the fingerprint inputting means is avoided since the users first press the call button to summon a response for which they are waiting.

The Office Action has also not responded to prior arguments that the references do not teach the handheld indoor unit having a video display for displaying the visitor's image or that the handheld indoor unit effects recording.

Claim 1 includes the following features:

the indoor unit being handheld configured to be held in hand and portable and having display means incorporated therein for displaying the visitor's image picked up by the image pickup means and unlock means for unlocking the lock means, [and]

the indoor unit being portable to an optional location and allowing, at the optional location, the resident to check the visitor displayed on the display means and, if necessary, unlock the lock means through the unlock means[.]

The Examiner again cites the von Bauer reference for teaching a display stating:

In an analogous art, von Bauer discloses the outdoor unit (door bell station, Fig. 1a, 31) having image pickup means (CCD camera, Fig. 1a, 45) for picking up an image of the visitor making a call with the outdoor unit (door bell station, von Bauer, Col. 7, lines 15 - 28), the indoor unit (video receiver station, Fig. 4, 250) being portable and having display means (the video receiver station

~~Docket No. F-7051~~~~Scr. No. 09/935,222~~

receives the appropriate signals from the door bell station and displays the received information on a TV) for displaying the visitor's image picked up by the image pickup means and the indoor unit (video receiver station) being portable to an optional location (the video receiver station is portable and can use any TV within its vicinity as a display) and allowing at the optional location the resident to check the visitor displayed on the display means (von Bauer, Col. 6, lines 34 - 51 and Col. 7, lines 28 - 34).

The above recitation erroneously contends that the use of a user's television set in conjunction with a separate the handheld controller is within a reading of the claim language reciting the indoor unit as having a display and being portable. Claim 1 now specifically requires that the display be incorporated into the indoor unit to avoid an improperly expansive reading of the claim. Thus, the von Bauer reference using a controller separate from the television set for controlling the door lock cannot suggest the claimed invention.

Finally, with regard to claim 3, the Examiner has failed to address where the recording function is done. In the claimed invention the recording is effected in the handheld unit. Thus, the combination of references does not lead one to incorporate a video display into a handheld indoor unit for controlling the door lock and messaging functions.

Claims 13 - 16 are rejected under 35 U.S.C. §103(a) as obvious over the Mozer, Bain, von Bauer, Scott, and Setlak references. The Examiner relies on the Setlak reference for teaching a conductive resin. It is respectfully submitted that the proffered combination of references cannot render the rejected claims obvious

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Docket No: F-7051

Ser. No: 09/935,222

because the Setlak reference fails to provide the teaching noted above with respect to providing a call button which is conductive in order to effect static discharge. Setlak makes no recognition of the problem of users failing to discharge consciously nor does it make the vaguest suggestion to incorporate the discharge function into a button used for a purpose other than discharging. Thus, the combination of prior art references fails to teach or suggest all the claim limitations.

Thus, it is respectfully submitted that the rejected claims are not obvious in view of the cited references for the reasons stated above. Reconsideration of the rejections of all claims and their allowance are respectfully requested.

ASSERTION OF SMALL ENTITY STATUS

Applicant hereby asserts small entity status. It is request that the Examiner acknowledge this assertion in the next Office Action and change the status of the application in the PTO database.

REQUEST FOR EXTENSION OF TIME

Applicant respectfully requests a two month extension of time for responding to the Office Action. Please charge the fee of \$225.00 for the extension of time to Deposit Account No. 10-1250.

~~Docket No. F-7051~~~~Ser. No. 09/935,222~~

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In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
JORDAN AND HAMBURG LLP

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